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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,306	11/09/2000	Kazue Sako	14051	5037
23389	7590	10/28/2004	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			ABDI, KAMBIZ	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	SAKO, KAZUE	
09/710,306		
Examiner Kambiz Abdi	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-7,9-14 and 16-22 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2-7,9-14 and 16-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12 January 2004</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1, 8, and 15 are canceled.
- Claims 2, 3, 6, 9, 10, 13, 16-21, and 22 are amended.
- Claims 2-7, 9-14, and 16-22 are considered.

Response to Arguments

2. Applicant's arguments filed 5 February 2004 have been fully considered but they are not persuasive for the following reasons:

In response to applicant argument regarding rejection of Claims 2, 9, and 16 under 35 U.S.C. § 103 (a);

3. The examiner believes that the argument that the applicant has put forward on regards to claims 1, 8, and 15 are not persuasive to over come the prior art of record. The reasoning behind the argument by the applicant is that the claims recite, "the present invention does not require a data center". Applicant is claiming that either Lee or Pierce references, either individually or in combination, do not disclose the above-mentioned limitation of the claims 2, 9, and 16. Examiner disagrees with the applicant and would like to bring the attention of the applicant to the fact that Lee clearly teaches the use of serial number in the revenue stamp and the utilization of such serial number in the process of the revenue stamp (See Lee figure 8, column 8, lines 31-41 and 52-59), as well as that Pierce clearly discloses that signature is created using information derived from the information available at the PSD. It clearly is different signature seed for each transfer of funds as the other data used in each signature can be different so the number of signature can be an infinite number. This information being indicia-related data generated at the Host PC, verifiable at another system (here the data center) (See Pierce column 4, lines 42-64, and column 5, line 64-column 6, line 8). As it is clear by Pierce teaching any data, which produces an invalid indicia that can be verified for its signature as a valid fund transfer indication is acceptable. There is no positive language reciting that no data center is required in the current form of the claims.

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4. Further, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., data center, without communication with a uniquely managed body, or who signing the signature can be different) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. Therefore, the current examiner maintains the previous rejection of the claimed invention as they have been amended and presented in their current form.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-7, 9-14, 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,285,990 to David K. Lee et al. in view of U.S. Patent 6,058,384 to Perry A. Pierce et al.

8. As per claims 2, 9, and 16, Lee discloses an electronic revenue stamp issuing apparatus, method, and storage device, comprising:

- a judging means for judging whether the amount of an electronic revenue stamp to be issued is equal to or less than a prepaid amount (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63);
- an issuing means for issuing said electronic revenue stamp as data on a document (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63), said issuer means giving a serial number with said data to said electronic revenue stamp, said data containing a digital signature of said electronic revenue stamp issuing apparatus on a

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message, said message including the document which said electronic revenue stamp is attached to, the amount of said electronic revenue stamp (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63), and an identifier of a receiver of said electronic revenue stamp, if said amount of said revenue stamp is judged to be equal to or less than said prepaid amount (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63);

- a balance amount reducing means for reducing said amount of said electronic revenue stamp from said prepaid amount if said electronic revenue stamp is issued (See Lee figures 2, 3, 5A-C and 7 and associated text, see column 4, lines 51-68, column 5, line 1-63, column 6, lines 1-68, and column 7, lines 1-25);

What is not clear and explicit in Lee is the usage of the signature for further security and additional information transfer within the indicia. Lee clearly discloses the use of digital token as means of secure transaction within the metering system and record keeping for further tracking of indicia issuing and book keeping.

However, Pierce clearly teaches the steps of using specifically a digital signature in order for further securing issuance and refunding of revenue stamps (See Pierce figure 2 and associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce teachings for creating revenue stamps and a more efficient, less processing time, and better security control of refunding unused revenue stamps. Additionally, what Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- a verifying means, wherein said verifying means receives a digital certificate from said receiver making an electronic revenue stamp invalid, containing a digital signature of said receiver, and varies whether said distal certificate making said electronic stamp invalid is valid or not by using said identifier of said receiver (See Pierce abstract, figures 1 and 2 along with the associated

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text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53);

- an amount increasing means for increasing said prepaid amount (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53); and
- an invalid electronic revenue stamp recording means for recording said distal certificate making an electronic revenue stamp invalid (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

9. As per claims 3, 10, and 17, Lee and Pierce teach all the limitations of claims 1, 8, and 15 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- said issuing means issues an issue number of said electronic revenue stamp issuing apparatus to said electronic revenue stamp, and
- said message include said issue number (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

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10. As per claims 4, 11, and 18, Lee and Pierce teach all the limitations of claims 2, 9, and 15 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- said verifying means verifies whether said digital certificate making electronic revenue stamp invalid is valid or not, by using said identifier of said receiver and an issue number of said electronic revenue stamp issuing apparatus (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

11. As per claims 5, 12, and 19, Lee and Pierce teach all the limitations of claim 2, further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- invalid electronic revenue stamp data for storing data of electronic revenue stamps made to be invalid (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

12. As per claims 6, 13, and 20, Lee and Pierce teach all the limitations of claims 1, 8, and 14 further;

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What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- an issued electronic revenue stamp recording means which records issued electronic revenue stamps (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53); and
- storing means for issued electronic revenue stamp data and invalid electronic revenue stamp data (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

13. As per claims 7, 14, and 21 Lee and Pierce teach all the limitations of claims 2, 9, and 15 further;

What Lee is not clear and explicit on is the following limitations. However, Pierce clearly teaches,

- said verifying means verifies that said digital certificate making electronic revenue stamp invalid is issued for an electronic revenue stamp issued by said electronic revenue stamp issuing apparatus and also issued by a receiver who is a valid receiver of said electronic revenue stamp, and also verifies that said digital certificate making electronic revenue stamp invalid was not used before (See Pierce abstract, figures 1and 2 along with the associated text, column 1, lines 19-64, column 2, lines 1-58, column 4, lines 1-64, column 5, lines 10-68 and column 6, lines 1-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the Lee and Pierce systems for creating revenue stamps and a more

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efficient, less processing time consuming, and better security control of refunding unused revenue stamps.

14. As per claim 22, Lee and Pierce clearly teach all the limitations of claim 15, further; Lee discloses,

- said program storage device storing said control program of said electronic revenue stamp issuing method is an IC card (See Lee figures 1, 2, 3 and 7 and associated text, abstract, and column 5, line 20-68, column 6, lines 1-68 and column 7, lines 1-64).

15. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

16. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of

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this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Kambiz Abdi
Examiner**

October 20, 2004

Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600